

REMARKS

The Official Action mailed December 19, 2007, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on April 12, 2001; June 17, 2002; July 17, 2002; August 14, 2002; January 27, 2003; August 21, 2003; December 8, 2003; June 1, 2004; November 26, 2004; December 17, 2004; May 25, 2005; November 25, 2005; December 1, 2005; May 30, 2006; November 27, 2006; April 4, 2007; and October 15, 2007.

A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 1, 2, 4-10, 13, 14 and 65-77 are pending in the present application. Claims 67-77 have been withdrawn from consideration by the Examiner (Box 4a, Office Action Summary; page 2, Paper No. 20071202). Accordingly, claims 1, 2, 4-10, 13 and 14 are currently elected, of which claims 1 and 2 independent. Claims 1 and 2 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action continues to request the Applicant's cooperation in correcting any errors of which the Applicant may become aware in the specification. In response to a previous request, in the *Amendment* filed May 25, 2005, the specification was amended to correct minor typographical errors. If there are any additional matters that require review or correct, the Applicant respectfully requests that the Examiner note such matters in a future Official Action, and the Applicant will correct any further errors in the specification of which the Applicant becomes aware.

Otherwise, the Applicant respectfully requests that the objection be reconsidered and withdrawn.

Paragraph 6 of the Official Action rejects claims 1, 2, 4-10, 13 and 14 as obvious based on the combination of U.S. Patent No. 6,909,114 to Yamazaki and U.S. Patent No. 6,238,754 to Shohara. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Independent claims 1 and 2 already recite a pixel electrode over a resin film over a coloring layer over a protective film in contact with a gate insulating layer and a second conductive film of an n-channel TFT. Also, claims 1 and 2 have been amended to recite "a resin film provided over a protecting film where at least a part of the resin film is in contact with the protecting film" and "a pixel electrode on and in contact with the resin film." For the reasons provided below, Yamazaki '114

and Shohara, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

It appears that the present Final Official Action mailed December 19, 2007, is identical to the non-final Official Action mailed July 13, 2007, except that the Examiner newly asserts that Yamazaki '114 teaches "a pixel electrode over the resin film (For Example: See Figure 35B)" (pages 4 and 5, Paper No. 20071202).

Figure 2C of Yamazaki '114 (reproduced below) is relied upon to teach an interlayer insulating film 130 (allegedly the "protective film" of the present claims) in contact with a gate insulating layer and a second conductive film of an n-channel TFT.

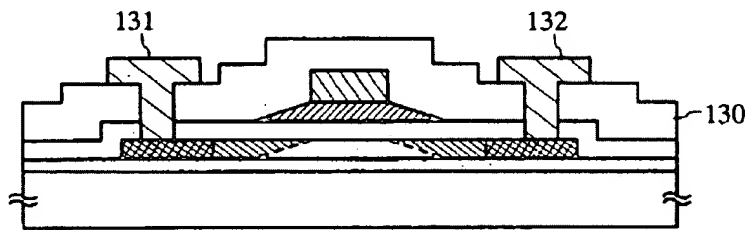
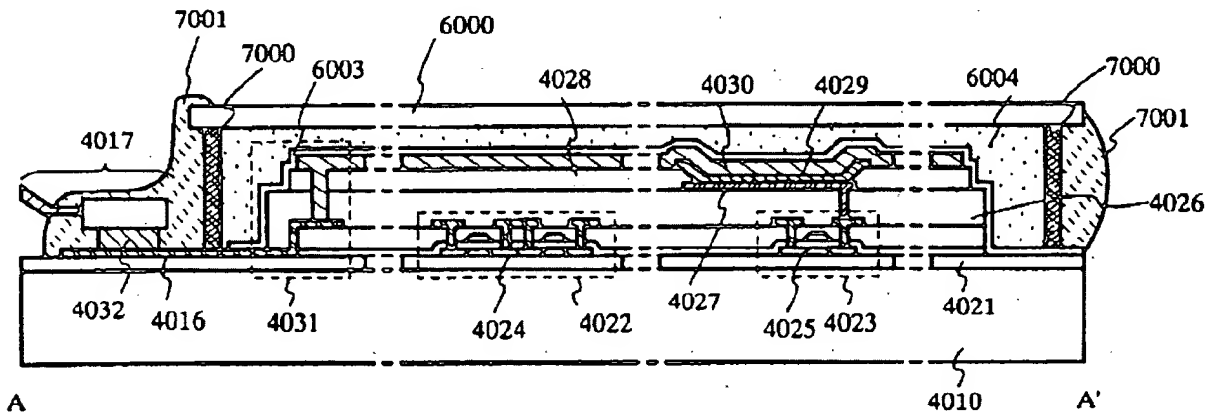
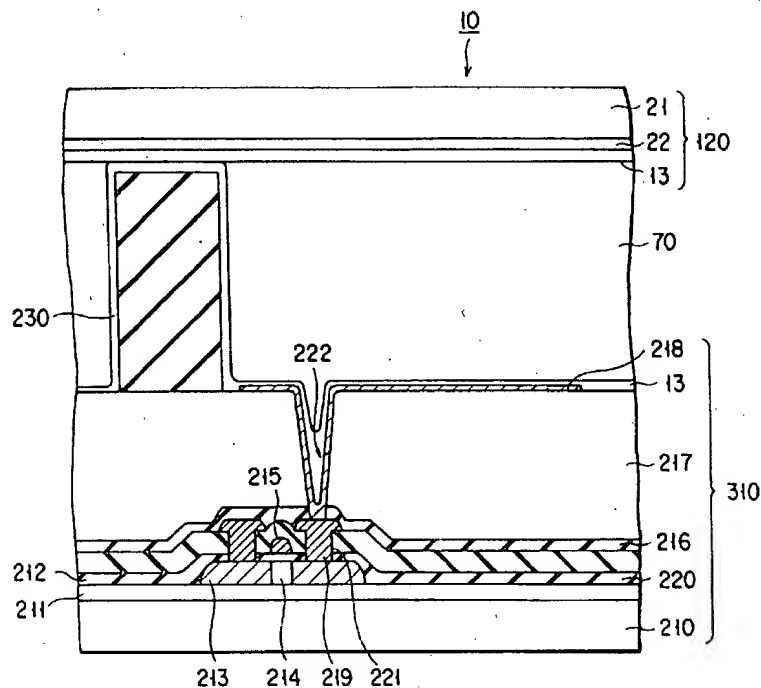


Figure 35B of Yamazaki '114 (reproduced below) is relied upon to allegedly teach a pixel electrode 4027. Also, the Applicant notes that pixel electrode 4027 is provided over interlayer insulating film 4026.



The Official Action does not explain how Figures 2C and 35B relate; however, presuming the Official Action could support a combination of Figures 2C and 35B, at best, Yamazaki '114 may teach a pixel electrode 4027 over an interlayer insulating film 4026 over an interlayer insulating film 130 in contact with a gate insulating layer and a

Shohara does not cure the deficiencies in Yamazaki '114. Figure 3 of Shohara (reproduced below) appears to teach that the columnar spacer 230 (relied upon to teach the “resin film” of the present claims) is located beside pixel electrode 218, that the spacer 230 is provided between colored layer 217 and counter substrate 120, and that the spacer 230 maintains a predetermined distance for the liquid crystal layer 70.



Even if the Examiner were able to demonstrate a reason to apply the spacer 230 of Shohara to Yamazaki '114, it appears that Shohara would teach forming such spacer 230, at best, beside a pixel electrode. As such, the alleged combination of Yamazaki '114 and Shohara would not teach or suggest a pixel electrode over a resin film over a coloring layer over a protective film in contact with a gate insulating layer and a second conductive film of an n-channel TFT.

Also, in addition to the arguments presented above, the Applicant respectfully submits that Yamazaki '114 and Shohara, either alone or in combination, do not teach or suggest the newly added features of claims 1 and 2, i.e. a resin formed over a protecting film where a part of the resin film is in contact with a protecting film, and a pixel electrode formed on and in contact with the resin film.

Since Yamazaki '114 and Shohara do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained.

Furthermore there is no proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Yamazaki '114 and Shohara or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be modified in the manner asserted in the Official Action, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

The test for obviousness is not whether the references "could have been" combined or modified as asserted in the Official Action, but rather whether the references should have been. As noted in MPEP § 2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original). Thus, it is respectfully submitted that the standard set forth in the Official Action is improper to support a finding of *prima facie* obviousness.

The Official Action concedes that Yamazaki '114 does not teach "a resin film provided over the protecting film and a coloring layer provided between the protecting

film and the resin film" (page 4, Paper No. 20071202). The Official Action relies on Shohara to allegedly teach "a resin film provided over the protecting film and a coloring layer (217) provided between the protecting film (216) and the resin film (230)" (Id.). The Official Action asserts that "[it] would have been obvious ... to modify the semiconductor device of Yamazaki to include a resin film provided over the protecting film and a coloring layer provided between the protecting film and the resin film as described in Shohara because it aids in providing good display characteristics" (Id.). The Applicant respectfully disagrees and traverses the above assertions in the Official Action.

Please incorporate the description of the deficiencies in Yamazaki '114 and Shohara noted in detail above. Since no liquid crystal layer is shown in Figure 35B of Yamazaki '114, it is not clear why one of ordinary skill in the art at the time of the present invention would have had any reason to apply the columnar spacer 230 of Figure 3 of Shohara to Yamazaki '114, much less why one would have a reason to insert such spacer 230 between the pixel electrode 4027 and the interlayer insulating film 130.


Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Yamazaki '114 and Shohara or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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